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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/719,321	11/21/2003	Dennis Osamu Hirotsu	AA551C	3072
27752 7590 05/12/2009 THE PROCTER & GAMBLE COMPANY Global Legal Department - IP Sycamore Building - 4th Floor 299 East Sixth Street CINCINNATI, OH 45202			EXAMINER CRAIG, PAULA L	
			ART UNIT 3761	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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THE PROCTER & GAMBLE COMPANY
Global Legal Department - IP
Sycamore Building - 4th Floor
299 East Sixth Street
CINCINNATI OH 45202

In re Application of:

HIROTSU, DENNIS OSAMU

Serial No.: 10/719,321

Filed: Nov. 21, 2003

Docket: AA551C

Title: DISPOSABLE ABSORBENT ARTICLES
CONTAINED IN PACKAGE HAVING
WINDOW

DECISION ON PETITION
under 37 CFR § 1.181

This is a decision on the petition filed on September 23, 2008 filed under 37 CFR § 1.183 seeking to have the rejections in the Examiner's Answer designated as new grounds of rejection.

The petition is being considered pursuant to 37 CFR § 1.181, rather than under 37 CFR § 1.183, and no fee is required.

The petition is GRANTED.

The following relevant facts show that:

- 1) A final rejection was mailed on Sep. 7, 2007 rejecting claims 1-3 and 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kuske (6,318,555) in view of Lash (5,897,542) and further in view of Brisebois (6,454,095).
- 2) In response to the final rejection and the advisory action, the appellant filed an appeal brief on May 7, 2008 to appeal the finally rejected claims.
- 3) On July 23, 2008, the examiner issued an examiner's answer. On page 11 of the Paragraph 10 of "Response to Arguments", the examiner essentially repeated the final rejection but added a statement on page 11 to address the packaging of different articles types together and the placing of colors and other indication means on article wrappers are well known in the art. In particular, the examiner cited three prior art references, namely, US patents to Sorkin, Miller and Nelson. The examiner cited these three references to support and show the common uses of colored items packaged together in a package with window opening.

- 4) On Jul. 2, 2007, the appellant filed the current petition arguing the examiner has improperly introduced three new references in support of her rejection and this constitutes new grounds of rejection raised in the examiner answer.

Analysis and Decision

The examiner has augmented her arguments in the examiner's answer by introducing three new references. If the prior art references in the final rejection of Sep. 7, 2007 are properly applied under 35 USC § 103, then it is not necessary to add this extrinsic evidence to show the claimed features are well known in the art. One skilled in the packaging art would have known what is well now and common practice in the art. For example, to package variety of colored absorbent articles together in a transparent top wall or windowed opening for visual identification purpose. This is tantamount to citing the Periodic Chart when looking up properties of elements. Therefore, this citation of three new references should not have been added in the examiner's answer to additionally support her arguments if unneeded. If the citation of three references is necessary to understand and explain the rejection, then all three references must be applied against the claims under the rejection. In the examiner's answer of July 23, 2008, the examiner listed these three new references under the Evidence Relied Upon section, which appears to be the prior art references against the claims under the rejection. By doing so, the addition of these three references in the examiner's answer constitute new grounds of rejection¹.

In order to clarify the record and comply with MPEP § 1207.03, the examiner is directed to: 1) vacate the examiner's answer of July 23, 2008; and 2) issue a revised examiner's answer without any reference to these newly cited references, if the examiner believes the final rejection of Sep. 7, 2007 is proper, or with the TC director's approval, to clearly identify the examiner's grounds of rejection in the revised examiner's answer as new grounds of rejection with any or all of the new references. Under the circumstance, the examiner always has the option to re-open prosecution (with supervisory approval) if these new references are used as prior art references against the claims.

Conclusion

For the foregoing reasons, the relief requested by petitioner is granted to the extent that the examiner's answer of July 23, 2008 is hereby vacated and a new revised examiner's answer will be mailed in due course.

¹ MPEP § 1207.03, last paragraph states: A new prior art reference >applied or< cited for the first time in an examiner's answer generally will constitute a new ground of rejection. If the citation of a new prior art reference is necessary to support a rejection, it must be included in the statement of rejection, which would be considered to introduce a new ground of rejection. Even if the prior art reference is cited to support the rejection in a minor capacity, it should be positively included in the statement of rejection. In re Hoch, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n. 3 (CCPA 1970). **>Where< a newly cited reference is added merely as evidence of the prior ** statement made by the examiner >as to what is "well-known" in the art which was challenged for the first time in the appeal brief<, the citation of the reference in the examiner's answer would not >ordinarily< constitute a new ground of rejection within the meaning of 37 CFR *> 41.39(a)(2)<. See also MPEP § 2144.03.

The application is being forwarded to the Art Unit for further processing consistent with this decision. Appellant may file a request for reconsideration of this decision, without fee. However, such a request must be filed within two months of the date of this decision. See 37 CFR 1.181. Any inquiry regarding this decision should be directed to Henry Yuen, Special Programs Examiner, at (571) 272-4856.

PETITION GRANTED.

 5/8/2009
Robert Olszewski, Director
Technology Center 3700